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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,565	06/05/2000	Yoshinori Miyazawa	1046.1214/JDH	7602

21171 7590 12/29/2005

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EXAMINER

NGUYEN, DUSTIN

ART UNIT PAPER NUMBER

2154

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/587,565		MIYAZAWA, YOSHINORI	
	Examiner		Art Unit	
	Dustin Nguyen		2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10-14 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-14 and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 2, 4-8, 10-14, 16-19 are presented for examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/07/2005 has been entered.

Response to Arguments

3. Applicant's arguments filed 10/07/2005 have been fully considered but they are not persuasive.
4. As per remarks, Applicants' argued that (1) the cited references do not teach the amended limitation of judging whether "a reply destination mail is an address of a mailing list capable of broadcasting the same E-mail to a plurality of destinations at one time by a predetermined single mail address".

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5. As to point (1), Hara discloses the step of extracting addresses from the header including the mail addresses of the global address [i.e. address of a mailing list] [Figure 4; col 4, lines 48-56; and col 7, lines 39-57], which the global address can transmit to plurality of transmission destination [i.e. broadcasting the same E-mail to a plurality of destinations] [col 1, lines 45-48] and all the mail addresses are registered into the database [i.e. a predetermined single mail address] [col 2, lines 16-19 and lines 29-34].

6. As per remarks, Applicants' argued that (2) the cited references do not teach the claimed limitation of claim 5, "a processing unit which stores, if the mail address extracted from the text of the E-mail received is not registered in the mail address book, a name of this unregistered mail address as a name unknown in the mail address book in a format of corresponding to the mail address".

7. As to point (2), the above limitation is rejected by Meister as disclosed below.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1, 2, 4, 7, 8, 10, 13, 14, 16 and 19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara [US Patent No 5,938,725], in view of Weber et al. [US Patent No 5,878,230].

10. As per claim 1, Hara discloses the invention substantially as claimed including an E-mail terminal device comprising:

a judging unit which judges whether or not a reply destination mail address extracted from an E-mail received is an address of a mailing list capable of broadcasting the same E-mail to a plurality of destinations at one time by a predetermined single mail address [col 2, lines 64-67; col 3, lines 51-60; and col 4, lines 48-56];

a selecting unit which displays the at least one extracted mail address as a candidate for a reply destination from which a specified reply destination can be selected [col 3, lines 14-28; and col 4, lines 2-11].

Hara does not specifically disclose

an extracting unit which automatically extracts at least one mail address contained in a text of the E-mail received when the reply destination mail address is the address of the mailing list, and does not extract any mail address contained in the text of the E-mail received when the reply destination mail address is not the address of the mailing list.

Weber discloses

an extracting unit which automatically extracts at least one mail address contained in a text of the E-mail received when the reply destination mail address is the address of the mailing list [i.e. if the IDP indicates third party addressing, then the system automatically updates the

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IDP with the third party addresses] [86, Figure 6; and col 5, lines 18-23], and does not extract any mail address contained in the text of the E-mail received when the reply destination mail address is not the address of the mailing list [i.e. if the IDP does not indicate third party addressing] [84, Figure 6; and col 5, lines 4-18].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hara and Weber because Weber's teaching would allow to reply to destination correctly without error.

11. As per claim 2, Hara discloses the invention substantially as claimed including an E-mail terminal device comprising:

a first extracting unit which automatically extracts a reply destination mail address from a mail header of an E-mail received [Figure 4; col 2, lines 64-67; and col 6, lines 18-26];

a selecting unit which displays all the extracted mail addresses as candidates for reply destinations from which a specified reply destination can be selected [col 3, lines 1-3; and col 6, lines 29-40];

a judging unit which judges whether or not a reply destination mail address extracted from an E-mail received is an address of a mailing list capable of broadcasting the same E-mail to a plurality of destinations at one time by a predetermined single mail address [col 2, lines 64-67; col 3, lines 51-60; and col 4, lines 48-56];

the second extracting unit, when the reply destination mail address is judged to be the address of the mailing list, automatically extracts the at least one mail address [col 3, lines 61-col 4, lines 11; and col 4, lines 48-56].

Hara does not specifically disclose

a second extracting unit which automatically extracts at least one mail address contained in a text of the E-mail received, wherein the second extracting unit, when the reply destination mail address is judged to be the address of the mailing list, automatically extracts the at least one mail address contained in a text of the E-mail received when the reply destination mail address is the address of the mailing list, and does not extract any mail address contained in the text of the E-mail received when the reply destination mail address is not the address of the mailing list.

Weber discloses

a second extracting unit which extracts at least one mail address contained in a text of the E-mail received [Figure 5D; col 7, lines 32-46; and col 9, lines 60-64], wherein the second extracting unit, when the reply destination mail address is judged to be the address of the mailing list, automatically extracts the at least one mail address contained in a text of the E-mail received when the reply destination mail address is the address of the mailing list [i.e. if the IDP indicates third party addressing, then the system automatically updates the IDP with the third party addresses] [86, Figure 6; and col 5, lines 18-23], and does not extract any mail address contained in the text of the E-mail received when the reply destination mail address is not the address of the mailing list [i.e. if the IDP does not indicate third party addressing] [84, Figure 6; and col 5, lines 4-18].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hara and Weber because Weber's teaching would allow to reply to destination correctly without error.

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12. As per claim 4, Hara discloses a storage unit including a mail address book by which whether or not the reply destination mail address extracted from the mail header of the E-mail received is the address of the mailing list, can be judged [col 1, lines 10-20 and lines 29-37].

13. As per claims 7, 8, and 10, they are method claimed of claims 1, 2, and 4, they are rejected for similar reasons as stated above in claims 1, 2, and 4.

14. As per claims 13, 14, 16, they are program product claimed of claims 1, 2, 4, they are rejected for similar reasons as stated above in claims 1, 2, 4.

15. As per claim 19, it is rejected for similar reasons as stated above in claims 1 and 4.

16. Claims 5, 6, 11, 12, 17 and 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara [US Patent No 5,938,725], in view of Weber et al. [US Patent No 5,878,230], and further in view of Meister et al. [US Patent No 6,671,718].

17. As per claim 5, Hara and Weber do not specifically disclose a processing unit which stores, if the mail address extracted from the text of the E-mail received is not registered in the mail address book, a name of this unregistered mail address as a name unknown in the mail address book in a format of corresponding to the mail address. Meister discloses a processing unit which stores, if the mail address extracted from the text of the E-mail received is not

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registered in the mail address book, a name of this unregistered mail address as a name unknown in the mail address book in a format of corresponding to the mail address [i.e. add complete address to the alert list if no alias] [134, Figure 5; and col 4, lines 55-col 5, lines 17]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hara, Weber and Meister because Meister's teaching would allow to identify all the addresses of an E-mail for further processing.

18. As per claim 6, Hara and Weber do not specifically disclose a display unit which displays, when visibly displaying all the extracted mail addresses as the reply destination candidates, the name of the mail address extracted from the text of the received E-mail and unregistered in the mail address book as the name unknown in the format of corresponding to the mail address. Meister discloses a display unit which displays, when visibly displaying all the extracted mail addresses as the reply destination candidates, the name of the mail address extracted from the text of the received E-mail and unregistered in the mail address book as the name unknown in the format of corresponding to the mail address [i.e. determining alias existence] [130, 134, Figure 5; and col 4, lines 55-col 5, lines 16]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hara, Weber and Meister because Meister's teaching of display unit would allow to alert user to the addresses of an e-mail message before it is sent [Meister, col 2, lines 6-19].

19. As per claim 11, it is method claimed of claim 5, it is rejected for similar reasons as stated above in claim 5.

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20. As per claim 12, it is method claimed of claim 6, it is rejected for similar reasons as stated above in claim 6.

21. As per claim 17, Meister discloses storing, if the mail address extracted from the text of the E-mail received is not registered in the mail address book, a name of this unregistered mail address as a name unknown in the mail address book in a format of corresponding to the mail address [i.e. local electronic address book] [col 4, lines 55-col 5, lines 5].

22. As per claim 18, it is program product claimed of claim 6, it is rejected for similar reasons as stated above in claim 6.

23. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Conclusion

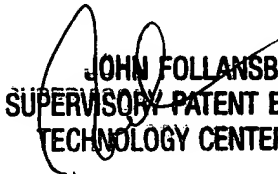
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex schedule.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Follansbee John can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dustin Nguyen
Examiner
Art Unit 2154


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